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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,658	02/04/2002	Heather N. Bean	10018569-1	6946
22879 7590 01/30/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER JERABEK, KELLY L				
ART UNIT 2622		PAPER NUMBER		
NOTIFICATION DATE 01/30/2008		DELIVERY MODE ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEATHER N. BEAN and MARK NELSON ROBINS

Appeal 2007-2990
Application 10/067,658
Technology Center 2600

Decided: January 28, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-7, 13-16, and 18-22. Claims 8-12 and 17 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' claimed invention relates to a method and apparatus for capturing and displaying image data in which image frames are captured at a frame rate. An image capture selector is provided having a first state in which images are captured at a first frame rate and a second user selectable operating state in which images are captured at a second frame rate which is different from the first frame rate. The image capture selector is switchable between first and second states during continuous image data capture. (Specification 4-6)

Claim 1 is illustrative of the invention and reads as follows:

1. A camera user interface assembly comprising:
a video capture selector having at least a first operating state in which said, camera captures image data at a first rate and a second user selectable operating state in which said camera captures image data at a second rate different from said first rate;
said selector being switchable between said first and second states during continuous image data capture.

The Examiner relies on the following prior art references to show unpatentability:

Lee	US 6,614,477 B1	Sep. 2, 2003 (filed Nov. 6, 1998)
Hamamura	US 6,628,336 B2	Sep. 30, 2003 (filed Jun. 25, 1997)
Ohkawara	US 6,630,950 B1	Oct. 7, 2003 (filed Mar. 17, 1999)
Niikawa	US 6,710,809 B1	Mar. 23, 2004 (filed Feb. 25, 2000)

Matsumoto	US 6,795,642 B2	Sep. 21, 2004 (filed Jul. 30, 2001)
Yamamoto	US 6,856,345 B1	Feb. 15, 2005 (filed Jun. 22, 2000)

Claims 1 and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lee.

Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Hamamura.

Claims 2-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Ohkawara.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Niikawa.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Matsumoto.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Matsumoto and Niikawa.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Hamamura and Yamamoto.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Hamamura and Ohkawara.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only

those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C § 102(e), does Lee have a disclosure which anticipates the invention set forth in claims 1 and 13?
- (ii) Under 35 U.S.C § 103(a), with respect to appealed claims 2-7, 14-16, and 18-22, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Lee with various combinations of the secondary references to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical*

Corp., 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127

S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(e) REJECTION

Independent claim 1

With respect to the 35 U.S.C. § 102(e) rejection of independent claim 1 based on the teachings of Lee, the Examiner indicates (Ans. 4-5) how the various limitations are read on the disclosure of Lee. In particular, the Examiner directs attention to the illustrations in Figure 2 of Lee as well as the portions of the disclosure at column 3, line 25 through column 5, line 45 of Lee. Further, the Examiner, while recognizing that Lee does not have an explicit disclosure of frame rate selection during continuous image data capture, nevertheless suggests that such feature is inherent within Lee. According to the Examiner (Ans. 15-16), the inherency of the variable frame rate during continuous image capture feature in Lee is based on the fact that Lee never discloses that the frame rate selection switch SEL is disabled at any time.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Lee so as to establish a prima facie case of anticipation. After considering the arguments of record, we find ourselves in agreement with Appellants'

contention that the Examiner has not established a factual basis for supporting an anticipation rejection based on inherency.

In particular, we agree with Appellants (App. Br. 10-12; Reply Br. 2) that, merely because Lee does not disclose that the frame rate selection switch SEL is disabled during continuous image capture, it does not *necessarily* follow that the frame rate selection switch of Lee is configured to be actuatable at any time. Similarly, although the Examiner has cited (Ans. 15) a portion of Lee (col. 3, ll. 35-48) which describes the generation of gate signals for each of a succession of image fields which are applied to the image capture device based on the commanded frame rate, there is no indication, nor does it *necessarily* follow that the commanded frame rate has changed, let alone that it has changed during the continuous capturing of image data as claimed.

To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citing *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269.

Independent claim 13

While we found Appellants' arguments to be persuasive with respect to the Examiner's anticipation rejection of independent claim 1, we reach the opposite conclusion with respect to the rejection of independent claim 13. We note that, while the language of claim 13 sets forth the generation of various image data sets at different frame rates, there is no requirement, in contrast to independent claim 1, that the different frame rates are selected during continuous image data capture.

Appellants' arguments in response to the Examiner's 35 U.S.C. § 102(e) rejection are directed to the alleged lack of disclosure in Lee of the "streaming" feature set forth in the last paragraph of claim 13. According to Appellants (App. Br. 14), Lee does not disclose that image data sets captured at different frame rates can be "streamed together."

We find, however, that Appellants' arguments are not commensurate with the scope of claim 13. As pointed out by the Examiner (Ans. 17-18), there is no requirement in the claim language that image data sets captured at different frame rates be streamed "together." Accordingly, we simply find no error in the Examiner's finding (Ans. 6) that Lee's disclosure (col. 4, ll. 9-31) of the generation of image data sets at different frame rates through the use of gate enable signals to generate output composite video satisfies the "streaming" requirement of claim 13.

Accordingly, since all of the claimed limitations are present in the disclosure of Lee, the Examiner's 35 U.S.C. § 102(e) rejection of independent claim 13 is sustained.

35 U.S.C. § 103(a) REJECTIONS

Dependent claims 2-5

We do not sustain this rejection. In addressing the requirements of these claims, which are directed to various physical features of the claimed variable frame rate selection switch, the Examiner has applied the disclosure of Ohkawara in combination with Lee. We find, nothing, however, in the disclosure of Ohkawara which overcomes the innate deficiencies of Lee in disclosing the claimed feature of switchable frame rate selection during continuous image data capture.

Dependent claims 6, 7, 16, and 19

We do not sustain the Examiner's obviousness rejection of these claims as well. The Examiner applied the Niikawa reference to Lee to address the feedback notification feature of claims 6 and 7, with the addition of Matsumoto to address the image frame storing features of claim 16, and the further addition of Hamamura to address the exterior switch feature of claim 19. As with the previously discussed Ohkawara reference, the Niikawa, Matsumoto, and Hamamura references do not overcome the deficiencies of Lee in disclosing the claimed switchable frame rate selection during continuous image data capture feature.

Independent claims 14 and 15

This rejection is also not sustained. Each of these claims contains, with slight difference in language, the feature of variable frame rate selection during continuous image data capture. The Examiner's addition of Matsumoto to Lee to address the additional captured image frame storing features does not overcome the previously discussed deficiencies of Lee.

Independent claim 18

As with previously discussed independent claim 13, we do not find Appellants' arguments to be persuasive with respect to the Examiner's obviousness rejection of claim 18. As with claim 13, independent claim 18, unlike independent claims 1, 14, and 15, does not contain a requirement that variable frame rate selection occur during continuous data capture.

Appellants' arguments in response do not contest the Examiner's addition of Hamamura of Lee to address the exterior selection switch feature of claim 18. Instead, Appellants contend (App. Br. 16-17; Reply Br. 4-5) that the language of claim 18 distinguishes over Lee since Lee does not disclose that the *same* switch is used for both the initiation of image data acquisition and for varying the frame rate.

We do not agree. Our reading of the disclosure of Lee indicates that the same frame selection switch SEL is used to initiate image data capture and to vary the frame rate, although not necessarily during continuous image data capture. In other words, the claim language does not preclude the initiation of an image capturing session with the variation of frame rate

during start and stop intervals during that same session as suggested by Lee through the use of Lee's *same* selection switch SEL.

In view of the above discussion, since Appellants' arguments have shown no error in the Examiner's 35 U.S.C. § 103(a) rejection, the Examiner's obviousness rejection of independent claim 18 is sustained.

Dependent claims 20-22

We also find no error and, accordingly, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claim 20 in which Hamamura and Yamamoto are added to Lee, as well as the rejection of claims 21 and 22 in which the Examiner has combined Hamamura and Ohkawara with Lee. Appellants have made no separate arguments as to the patentability of claims 20-22 but instead have chosen (App. Br. 19 and 24) to let these claims fall with independent claim 18.

CONCLUSION

In summary, with respect to the Examiner's 35 U.S.C. § 102(e) rejections of appealed claims 1 and 13, we have not sustained the rejection of claim 1, but have sustained the rejection of claim 13. With respect to the Examiner's 35 U.S.C. § 103(a) rejection of the appealed claims, we have not sustained the rejection of claims 2-7, 14-16, and 19, but have sustained the rejection of claims 18 and 20-22. Accordingly, the Examiner's decision rejecting appealed claims 1-7, 13-16, and 18-22 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (effective September 13, 2004).

AFFIRMED-IN-PART

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Appeal 2007-2990
Application 10/067,658

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